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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,039	01/09/2004	John E. Jones	47171-354USD1	8706

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EXAMINER

JOHNS, ANDREW W

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,039

Applicant(s)

JONES ET AL.

Examiner

Andrew W. Johns

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-17, 19-30, 32-35, 38-44, 46-49, 52-60, 62-69 and 71 is/are rejected.
- 7) ☒ Claim(s) 7, 18, 31, 36, 37, 45, 50, 51, 61 and 70 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/22/05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 C.F.R. § 1.121(d) are required in this application because the proposed correction filed 27 September 2004 is approved by the examiner. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 62 and 71 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitations of "the check" and "checks per minute" in claims 62 and 71 are unclear and confusing because no checks are recited or defined in the preceding language of claims 53 or 63, from which these claims variously dependent. Therefore, it is unclear what checks are

referred to and modified by these recitations, so that the exact metes and bounds of the claim can not be readily ascertained.

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 53, 55-56, 59-60, 62-63, 65, 68-69 and 71 are rejected under 35 U.S.C. § 102(e) as being anticipated by Conant (US 5,680,472 A).

Conant teaches a document processing system and method that includes an input receptacle for receiving currency bills (14 in Figure 1; column 3, lines 42-43), each currency bill having a wide and narrow dimension (as shown in Figure 1, bills 12 are generally rectangular in shape, having both a width and a length); at least one output receptacle (40, 42 in Figure 1; column 4, lines 9-10); a bill imager (30 in Figure 1; column 3, line 52 through column 4, line 4); and a transport mechanism coupled to the input receptacle for receiving the currency bills from the input receptacle and transporting the currency bills past the bill imager to the at least one output receptacle (column 3, lines 43-52), with their narrow dimension parallel to a direction of transport (see Figure 1, the direction of travel is indicated by arrow 66 and is parallel to the narrow dimension (i.e., width) of the bills 12); wherein the bill imager captures an image of each passing bill (column 4, lines 31-41), as stipulated by claims 53 and 63. In addition, Conant further teaches that each bill includes field data imprinted thereon and the bill imager processes

the captured image to recognize the imprinted field data (column 4, lines 55-57), as further required by claim 55; stores the bill images (column 5, lines 3-5), as variously set forth in claims 56 and 65; that the output receptacle can include a plurality or two bins (column 5, lines 51-56), as defined in claims 59-60 and 68-69; and that the bills are transported at a rate of at least 800 bills per minute (column 4, lines 12-13), as set forth in claims 62 and 71.

Claim Rejections - 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-5, 10-12, 14-16, 21-25, 27-29, 34-35, 38-39, 41-43, 48-49 and 52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holt (US 5,504,822 A), in view of Conant (US 5,680,472 A).

Holt teaches a check processing system and method (column 5, lines 61-63) that includes an input receptacle for receiving checks (i.e., "a hopper, magazine or other mechanical check storage system," column 5, lines 65-66), each check having a wide and a narrow dimension (as shown in Figure 1A, the checks are generally rectangular with a width and length) and including field data imprinted on the check (Figure 1A, the check includes fields 312, 315, 316, 318, 319, etc.); at least one output receptacle (338 in Figure 2A); a check imager (331 in Figure 2A); and a transport mechanism coupled to the input receptacle for receiving the checks from the input receptacle and transporting the checks past the check imager to the at least one output receptacle (i.e., the automatic check feeder; column 5, lines 64-67); wherein the check imager captures an

image of each passing check (column 5, line 67 through column 6, line 2), and wherein the check imager processes the captured image to recognize the imprinted field data (332 in Figure 2A; column 7, lines 1-15), as variously required by independent claims 1, 12, 25 and 39. Furthermore, Holt further teaches that the imprinted field data recognized by the system is numeric check amount data from a courtesy field (332 in Figure 2A; column 7, lines 1-15), as variously stipulated by claims 3-4, 14-15, 27-28 and 41-42; that the check images are stored in a memory (30 in Figure 7), as further required by claims 5, 16, 29 and 43; and that the at least one receptacle can include a plurality of two or more bins (as shown in Figure 2A; the output receptacle 338 includes 40 pockets), as additionally stipulated by claims 10-11, 21-22, 34-35 and 48-49.

However, while Holt does teach that the checks are transported in a predetermined orientation (column 5, line 65), Holt fails to specifically teach what orientation(s) should be used for this predetermined orientation. Therefore, Holt fails to specifically teach that the checks are transported with their narrow dimension parallel to a direction of transport, as further required by independent claims 1, 12, 25 and 39. Holt also fails to specifically teach that the checks are transported at a rate of at least 800 per minutes, as required by claims 23, 24, 38 and 52.

Conant teaches a financial document evaluation system that teaches that the documents can be transported either with the narrow dimension parallel to the direction of travel (see Figure 1, the direction of travel is indicated by arrow 66 and is parallel to the narrow dimension (i.e., width) of documents 12) or with the wide dimension (i.e., length) parallel to the direction of travel (column 11, lines 60-63). Conant also teaches that the documents are transported past the imager at a rate of at least 800 per minute (column 4, lines 12-13). Because Conant suggests that the particular orientation of the document with respect to the direction of travel is a matter of

design choice, it would have been obvious to one of ordinary skill in the art to set the predetermined orientation of Holt to accommodate the narrow dimension parallel to the direction of transport, as such an orientation would accommodate a shorter transport path and higher speed processing. In addition, Conant demonstrates that documents can be accurately recognized at a high rate of speed, so that it would be obvious to use such high speeds in the Holt system. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention.

9. Claims 2, 6, 8, 13, 17, 19, 26, 30, 32, 40, 44 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holt and Conant as applied to claims 1, 3-5, 10-12, 14-16, 21-25, 27-29, 34-35, 38-39, 41-43, 48-49 and 52 above, and further in view of Cahill et al. (US 5,678,046 A).

While Holt and Conant variously meet a number of the limitations of the claimed invention, as pointed out more fully above, neither Holt nor Conant specifically teaches that the imprinted field data comprises MICR data, as variously required by claims 2, 13, 26 or 40; electronically tagging recognized field data to the check images, as further stipulated by claims 6, 17, 30 and 44; or outputting the check images over a communications channel, as set forth in claims 8, 19, 32 and 46.

Cahill et al. teaches a check processing system and method that transports checks (column 14, lines 59-67) past an imager (204 in Figure 3) and recognizes data from fields within the check, wherein the imprinted field data includes MICR data (column 14, lines 62-64; OCR extracts information from at least the MICR fields); electronically tagging the check image files with the information from fields within the checks (column 18, lines 44-62); and transmitting the tagged check images over a communications channel (i.e., to an accounting system 10-11 in

Figure 2). Because both Holt and Cahill et al. each teach systems for automated scanning and processing of check images, and further because Cahill et al. teaches a robust technique for archiving and processing checks, it would have been obvious to one of ordinary skill in the art to incorporate these features of Cahill et al. into the system and method of Holt so as to improve the robustness and functionality of the check processing therein.

10. Claims 9, 20, 33 and 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holt and Conant as applied to claims 1, 3-5, 10-12, 14-16, 21-25, 27-29, 34-35, 38-39, 41-43, 48-49 and 52 above, and further in view of Raterman et al. '824 (WO 93/23824 A1).

While Holt and Conant variously meet a number of the limitations of the claimed invention, as pointed out more fully above, neither Holt nor Conant specifically teaches that the output receptacle can include a single bin, as further required by claims 9, 20, 33 and 47.

Raterman et al. '824 teaches a document evaluation device (shown generally in Figure 11, for example) for receiving a stack of documents (page 8, lines 11-12) and rapidly evaluating all the documents in the stack (page 8, lines 15-19), including a single output receptacle for receiving the documents after the documents have been evaluated (242 in Figure 11; page 31, lines 9-11). Because Raterman et al. '824 provides for a compact system for processing financial documents, it would have been obvious to use a single bin in the Holt system to improve its portability. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention.

11. Claims 57 and 66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conant as applied to claims 53, 55-56, 59-60, 62-63, 65, 68-69 and 71 above, and further in view of Cahill et al.

While Conant meets a number of the limitations of the claims, as pointed out more fully above, Conant fails to specifically teach outputting the bill images over a communications channel, as further required by claims 57 and 66.

Cahill et al. teaches a financial document processing system and method that transports the documents (column 14, lines 59-67) past an imager (204 in Figure 3) and recognizes data from fields within the documents, and transmits the document images over a communications channel (i.e., to an accounting system 10-11 in Figure 2). Because both Conant and Cahill et al. each teach systems for automated scanning and processing of financial document images, and further because Cahill et al. teaches a robust technique for archiving and processing these documents, it would have been obvious to one of ordinary skill in the art to incorporate these features of Cahill et al. into the system and method of Conant so as to improve the robustness and functionality of the bill processing therein.

12. Claims 58 and 67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conant as applied to claims 53, 55-56, 59-60, 62-63, 65, 68-69 and 71 above, and further in view of Raterman et al. '824.

While Conant meets a number of the limitations of the claims, as pointed out more fully above, Conant fails to specifically teach that the output receptacle can include a single bin, as further required by claims 58 and 67.

Raterman et al. '824 teaches a document evaluation device (shown generally in Figure 11, for example) for receiving a stack of documents (page 8, lines 11-12) and rapidly evaluating all the documents in the stack (page 8, lines 15-19), including a single output receptacle for receiving the documents after the documents have been evaluated (242 in Figure 11; page 31, lines 9-11). Because Raterman et al. '824 provides for a compact system for processing financial

documents, it would have been obvious to use a single bin in the Conant system to improve its portability. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

14. Claims 1, 8-12, 20-25, 32-35, 38-39, 46-49 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6 and 17 of U.S. Patent No. 6,647,136 to Jones et al. in view of Conant.

Claim 1 of the '136 patent sets forth substantially every limitation of claims 1, 24, 25 and 38 of the instant application, except the requirements that the checks have a narrow dimension and a wide dimension and that they be transported with the narrow dimension parallel to the direction of transport. However, Conant teaches that documents can be transported in this fashion in a similar system (see Figure 1, the direction of travel is indicated by arrow 66 and is parallel to the narrow dimension (i.e., width) of the bills 12). Because Conant suggests that the particular orientation of the document with respect to the direction of travel is a matter of design choice, it would have been obvious to one of ordinary skill in the art to use such an orientation in

the system defined by claim 1 of the '136 patent. Furthermore, while claim 1 of the '136 patent includes additional elements not stipulated by the instant claims, the use of the transitional term "comprising" in the instant claims fails to preclude the possibility of such additional features, so that the instant claims fail to define a patentably distinct invention. In addition, claim 2 of the '136 patent sets forth the additional limitation of instant claims 9 and 33; claim 3 of the '136 patent sets forth the additional limitation of instant claims 11 and 35; claim 6 of the '136 patent sets forth the additional limitation of instant claims 8 and 32; and claim 17 of the '136 patent sets forth the additional limitation of instant claims 10 and 34, so that none of these claims define patentably distinct inventions.

Claims 12, 20-23, 39, 46-49 and 52 are method claims that variously correspond to the system claims discussed above. The operations that make of the claimed method would be readily apparent to one of ordinary skill in the art in view of the elements of the system stipulated in the system claims, so that these claims are also not patentably distinct from the claims of the '136 patent.

15. Claims 53-55, 57-60, 63-64 and 66-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2-3, 7, 13 and 18 of U.S. Patent No. 6,603,872 to Jones et al. in view of Conant.

Claim 1 of the '872 patent sets forth substantially every limitation of claims 53 and 55 of the instant application, except the requirements that the checks have a narrow dimension and a wide dimension and that they be transported with the narrow dimension parallel to the direction of transport. However, Conant teaches that documents can be transported in this fashion in a similar system (see Figure 1, the direction of travel is indicated by arrow 66 and is parallel to the narrow dimension (i.e., width) of the bills 12). Because Conant suggests that the particular

orientation of the document with respect to the direction of travel is a matter of design choice, it would have been obvious to one of ordinary skill in the art to use such an orientation in the system defined by claim 1 of the '872 patent. Furthermore, while claim 1 of the '872 patent includes additional elements not stipulated by the instant claims, the use of the transitional term "comprising" in the instant claims fails to preclude the possibility of such additional features, so that the instant claims fail to define a patentably distinct invention. In addition, claim 2 of the '872 patent sets forth the additional limitation of instant claim 58; claim 3 of the '872 patent sets forth the additional limitation of instant claim 60; claim 7 of the '872 patent sets forth the additional limitation of instant claim 57; claim 13 of the '872 patent sets forth the additional limitation of instant claim 59; and claim 18 of the '872 patent sets forth the additional limitation of instant claim 54, so that none of these claims define patentably distinct inventions.

Claims 63-64 and 66-69 are method claims that variously correspond to the system claims discussed above. The operations that make of the claimed method would be readily apparent to one of ordinary skill in the art in view of the elements of the system stipulated in the system claims, so that these claims are also not patentably distinct from the claims of the '872 patent.

Allowable Subject Matter

16. Claims 7, 18, 31, 36-37, 45, 50-51, 61 and 70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Applicant is advised that should claims 37 and 51 be found allowable, claims 61 and 70 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the

same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See M.P.E.P. § 706.03(k).

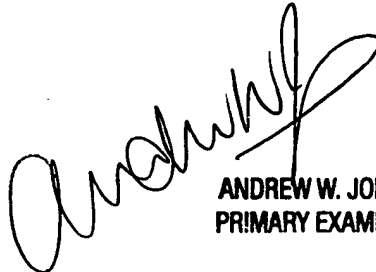
Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Johns whose telephone number is (571) 272-7391. The examiner is normally available Monday through Friday, at least during the hours of 9:00 am to 3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address: andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail communications. See M.P.E.P. § 502.03)

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Joseph Mancuso, can be reached at (571) 272-7695. The fax phone number for this art unit is (571) 273-8300. In order to ensure prompt delivery to the examiner, all unofficial communications should be clearly labeled as "Draft" or "Unofficial."

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center Receptionist whose telephone number is (571) 272-2600.

A. Johns
5 October 2005


ANDREW W. JOHNS
PRIMARY EXAMINER